

REMARKS

I. Requirement for Restriction

The Patent Office has asserted that there is no single inventive concept uniting the following four groups of claims.

- 1) Group I (claims 1-19 and 30-31) drawn to a compound comprising a steroid hormone stably linked to a DNA interacting molecule, and a method for the preparation of the same compound;
- 2) Group II (claims 20-24 and 27-28) drawn to a complex comprising a steroid hormone stably linked to a DNA interacting molecule complexed to a nucleic acid molecule, a method for the preparation of the complex and use of the complex for introducing a nucleic acid molecule into the nucleus of a cell;
- 3) Group III (claims 25-26) drawn to cell transfected with a complex comprising a steroid hormone stably linked to a DNA interacting molecule complexed to a nucleic acid molecule and use of the same cell for the medical treatment of a human; and
- 4) Group IV (claim 29) drawn to an assay comparing the expression of expressible genes between cells transfected with the DNA-complex of the present invention and non-transfected cells.

H. Election

Applicants elect for further prosecution on the merits, the invention of Group I (claims 1-19 and 30-31). Consistent with the Examiner's requirements, applicants also hereby elect the species of "glucocorticoid," *with traverse*. Claims 1-19 and 30-31 are readable on this species. Also, applicants hereby elect the species of "incorporating molecules." Claims 1-13, 17-19 and 30-31 are readable on this species.

III. Traversal of Restriction Requirement

The restriction requirement includes an allegation that, if Group I is elected, further restriction is required because Group I contains claims directed to patentably distinct species of claim 12. Applicants request that the restriction requirement be reconsidered

because the Examiner has not shown that a serious burden would be required to examine the entire claim 12. M.P.E.P. §803.02 provides:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions.

A person skilled in the art knows that glucocorticoids, mineralcorticoids, and androgens form the corticosteroid group. These steroid hormones (glucocorticoids, mineralcorticoids, and androgens) share a common structure (basic 21 carbon-atom ring structure) and common utility (e.g., hormonal replacement therapy) (See Exhibit A, printout of Internet medical dictionary, Dept of Medical Oncology, University of Newcastle, The CancerWEB Project, 1997-2002). Therefore, it would not be a serious burden to search and examine at the very least glucocorticoids, mineralcorticoids, and androgens together. A search relating to glucocorticoids, mineralcorticoids, and androgens would overlap, and the Examiner has not shown that an undue burden would be produced by the combined search.

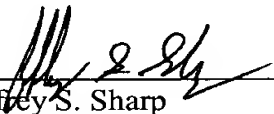
CONCLUSION

Should the Examiner wish to discuss any issues of form or substance in order to expedite allowance of the pending application, he is invited to contact the undersigned attorney at the number indicated below.

-----Respectfully submitted,-----

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